

REMARKS

Claims 32-57 and 72-76 were pending in this application prior to this Response, with claims 38 and 40 being withdrawn pursuant to a restriction requirement. By the present communication, no claims are added, claims 38, 40, and 76 have been cancelled without prejudice, and claim 32 has been amended to define Applicants' invention with greater particularity. The amendments add no new matter, being fully supported by the pending application and original claims. Accordingly, claims 32-37, 39, 41-57, and 72-75 are pending in this application.

The Rejection under 35 U.S.C. § 112, Second Paragraph

Applicants respectfully traverse the rejection of claims 32-57 and 72-76 under 35 U.S.C. § 112, second paragraph, as being indefinite in recitation in claim 32 of the phrase "wherein the isopeptidase activity deconjugates a modifier protein". However, as requested by the Examiner, to overcome the rejection with respect to the phrase at issue, claim 32 has been amended to recite, "Wherein the polypeptide having isopeptidase activity deconjugates a modifier protein".

In addition, the Examiner requests removal in claim 32 of the hyphens in "of-identifying" (line 1) and "wherein-a" (line 11). Accordingly, claim 32 has been amended to remove the extraneous hyphens in lines 1 and 11.

Further with respect to claim 32, the Examiner has requested identification of the JAM domain "HXHXXXXXXXXXXD" as SEQ ID NO:1. In accordance with the Examiner's request, claim 32 has further been amended to insert "(SEQ ID NO:1)" following recitation of the JAM domain sequence.

With regard to claim 76, the Examiner points out that the subject matter of 76 becomes redundant in view of the amendment to claim 32 clarifying that the activity is provided by the

polypeptide. To avoid redundancy in view of this amendment, Applicants have cancelled claim 76 without prejudice.

In view of the above amendments, Applicants submit that the pending claims meet all requirements under 35 U.S.C. § 112, second paragraph, and reconsideration and withdrawal of the rejection thereunder are respectfully requested.

The Double Patenting Rejection

Applicants respectfully traverse the rejection of claims 32-37, 39, 41-57 and 72-76 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 37-66 of copending Application No. 10/340,578

To overcome the rejection, Applicants submit herewith a Terminal Disclaimer disclaiming the terminal part of any patent granted on the subject matter of the above-identified Application and agreeing that any patent so granted on the above-identified application shall be enforceable only for and during such period that the legal title to the subject matter of said patent shall be the same as the legal title to any patent that may be granted on the subject matter of U.S. Patent Application Serial 10/340,578. In view of the Terminal Disclaimer submitted herewith, Applicants submit that U.S. Patent Application Serial No. 10/340,578 is not available as prior art against this application.

In view of the Terminal Disclaimer submitted herewith and the above remarks, Applicants respectfully request reconsideration and withdrawal of the provisional rejection of claims 32-37, 39, 41-57 and 72-76 under for obviousness type double patenting.

In view of the above amendments and remarks, it is believed that all rejections have been overcome and passage of the claims to allowance is respectfully requested.

In re Application of:

Cope et al.

Application No.: 10/047,253

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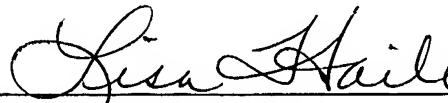
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Attorney Docket No.: CIT1510-4

If the Examiner would like to discuss any of the issues raised in the Office Action, the Examiner is encouraged to call the undersigned so that a prompt disposition of this application can be achieved.

Respectfully submitted,

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Enclosure: Terminal Disclaimer